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In re application of

Seiji UMEMOTO, et al.

Appln. No.: 09/851,970

Confirmation No.: 4097

Filed: May 10, 2001

For: REFLECTION TYPE LIQUID-CRYSTAL DISPLAY DEVICE

Group Art Unit: 2883

Examiner: Timothy L. RUDE

PAPER(S) FILED ENTITLED:

- 1) Petition from Restriction Requirement Under 37 C.F.R. §1.144.
- 2) Petition for Extension of Time (in duplicate with Check No. 290659 in the amount of \$450.00).

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q64435

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Filed: May 10, 2001

For: REFLECTION TYPE LIQUID-CRYSTAL DISPLAY DEVICE

PETITION FROM REQUIREMENT FOR RESTRICTION UNDER 37 C.F.R. § 1.144

ATTN: Technology Center Director
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

FILED
JAN 24 2006

Sir:

Applicants hereby petition the Technology Center Director to review the Election of Species requirement issued in the September 7, 2005 *Office Action* in the above-named Application.

I. Procedural History

In a June 27, 2005 *Amendment* in response to a January 27, 2005 *Office Action*, Applicants, *inter alia*, added several new claims 21-44 to the above-named Application. As noted in the June 27, 2005 *Amendment*, these claims are similar to other claims 1-20 in the Application, but “recite the features of the invention in further different language.”

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In response, the Examiner issued an *Election of Species Requirement* in a September 7, 2005 *Office Action*, in which he alleged that new claims 21-44 were directed to a different species than claims 1-20 (although he specified no particular species in the *Office Action*, as discussed below).

Applicants' representative requested that Examiner Rude reconsider his position regarding the *Election of Species Requirement* in a telephone conference on September 21, 2005, for at least the reasons discussed below. Examiner Rude refused.

Applicants' representative then attempted to contact Examiner Rude's supervisor, Examiner Frank Font. Examiner Font failed to return Applicants' representative's numerous phone calls over a three week period. Applicants' representative then contacted Director Falcone. Soon thereafter, Examiner Font returned Applicants' representative's phone calls, and agreed that the Election of Species requirement issued in the September 7, 2005 *Office Action* seemed to be improper. However, Examiner Font requested that Applicants file a complete written response so that he could review the case with Examiner Rude. Applicants complied with this request by way of a *Response* filed December 7, 2005.

Unfortunately, it appears that Examiner Font played no role in reviewing Applicants' December 7, 2005 *Response*, as Examiner Rude has issued an *Advisory Action*, dated December 21, 2005, which is signed by Examiner Kianni. In the *Advisory Action*, Examiner Rude continues to insist that the *Election of Species Requirement* in the September 7, 2005 *Office Action* is proper.

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In view of the above, Applicants respectfully submit that reconsideration of the *Election of Species Requirement* has clearly been requested, and therefore that this *Petition* is timely in view of 37 C.F.R. § 1.144.

II. Reasons Why The Election of Species Requirement Is Improper Presented In The December 7, 2005 Response

In the *Election of Species Requirement* in the September 7, 2005 *Office Action*, the Examiner alleged that claims 21-44 are “directed to inventions that are independent or distinct from the invention originally claimed.” Thus, the Examiner withdrew claims 21-44 from consideration, alleging that claims 1-20 have been constructively elected by original presentation. Applicants continue to disagree with this Election of Species Requirement.

First, the Examiner alleges that independent claim 1 recites a reflection type liquid-crystal display device comprising a visual-side substrate including: (1) a transparent substrate; (2) a transparent layer lower in reflective (refractive) index than the transparent substrate; and (3) a transparent electrode. Applicants agree that original claim 1 was so directed, and point out that these features read on the exemplary embodiment of FIG. 1, which shows a visual side substrate including: (1) a transparent substrate (e.g., element 21 in FIG. 1); (2) a low refractive index transparent layer (e.g., element 22 in FIG. 1); and (3) a transparent electrode (e.g., element 24 in FIG. 1).

Newly added claim 21 is similar to original claim 1, but recites, *inter alia*, “a visual-side substrate comprising a transparent layer, a low-refractive-index transparent layer lower in

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refractive index than the transparent layer, and a transparent electrode layer.” In other words, *inter alia*, independent claim 21 recites a “transparent layer,” rather than the “transparent substrate” of independent claim 1, as being a part of the recited “visual side substrate.”

Nevertheless, both the “transparent layer” of claim 21 and “transparent substrate” of claim 1 read on element 21 in FIG. 1. In fact, claim 21 in its entirety reads on FIG. 1, just as claim 1 does.

Newly added claim 40 is similar to pending claim 20, but recites, *inter alia*, “a visual-side substrate, on an upper surface of the liquid crystal layer, comprising a transparent electrode layer, a low-refractive-index transparent layer on the transparent electrode layer, and a transparent layer on the low-refractive-index transparent layer, wherein the low-refractive-index transparent layer is lower in refractive index than the transparent layer.” In other words, *inter alia*, independent claim 40 recites a “transparent layer,” rather than the “transparent substrate” of independent claim 20, as being a part of the recited “visual side substrate.” Nevertheless, both the “transparent layer of claim 40” and “transparent substrate” of claim 20 read on element 21 in FIG. 1. In fact, claim 40 in its entirety reads on FIG. 1, just as claim 20 does.

However, despite the fact that all of the independent claims 1, 20, 21 and 40 read on FIG. 1 of the Application, the Examiner alleged that independent claims 21 and 40 “are drawn to alternate species of the invention limited to visual-side substrates that do not read on the originally claimed visual-side substrate [of claim 1] . . . because they do not comprise a visual-side substrate including a transparent substrate.” Thus, it is believed that the Examiner is alleging that new claims 21 and 40 are directed to a different species of the invention simply

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because they recite a “transparent layer” rather than the “transparent substrate” of claims 1 and 20. Applicants respectfully submit that this is not proper, as: (1) the Examiner has not complied with the basic requirements of making an election requirement; and (2) the differences in recitations of the respective claims do not signify that there are different species of the invention.

First, as indicated in MPEP § 809.02(a), when requiring an election of species, the Examiner should: (1) “identify generic claims or indicate that no generic claims are present;” (2) “clearly identify each … of the disclosed species, to which claims are to be restricted[,] … as the species of figures 1, 2, and 3 or the species of examples I, II, and III, respectively;” (3) “[p]rovide reasons why the species are independent or distinct.” The Examiner has not followed a single one of these courses of action, and has therefore failed to adequately advise Applicants as to what embodiments the Examiner considers to be distinct species.

Second, the Examiner’s allegation that claim recitations themselves somehow provide the basis for identifying different species of the invention is also incorrect. Rather, as explained in MPEP § 806.04(e), “[c]laims are definitions of inventions. Claims are never species. The scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim), or a claim may include two or more of the disclosed embodiments within the breadth and scope of the claim (and thus be designated a generic or genus claim).”

In this instance, the scope of each of the independent claims 1, 20, 21 and 40 encompasses the embodiment shown in FIG. 1 of the Application. Thus, independent claims 1,

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20, 21 and 40 are, at the very least, species claims with respect to the embodiment of FIG. 1. As the species shown in FIG. 1 has already been prosecuted (via claim 1), the Examiner cannot now require a restriction to a different species.

Additionally, independent claims 1, 20, 21 and 40 are believed to be generic to all of the configurations shown in FIGS. 1-8 of the invention.

III. The Examiner's Arguments In the December 21, 2005 Advisory Action

In the December 21, 2005 *Advisory Action*, the Examiner alleges that the December 7, 2005 *Response* did not overcome the Election of Species Requirement of the September 7, 2005 *Office Action* because:

Arguments are not persuasive. It is respectfully pointed out that Applicant argues claim 1 reads on Figure 1, however, Applicant does not cite which structure is the visual side substrate. Applicant attributes item 21 to be the transparent substrate, but examiner cannot determiner which structure is the visual side substrate, and Applicant did not indicate/argue which structure is the visual side substrate. Examiner concludes Figure 1 does not fully illustrate the structure of claim 1. Please note that originally presented claims are considered to be self-enabling when one of ordinary skill would be expected to know how to make and use that which is claimed. Examiner considers originally presented claim 1 to be such a self-enabling claim, since a visual side substrate including a transparent substrate is very common in the subclass of front lit LCDs.

IV. Applicants' Further Response

The Examiner's arguments are not understood. Independent claim 1 clearly reads on the embodiment shown in FIG. 1 of the Application.

First, the Examiner has not previously alleged that the Figures of the instant Application are not representative of the independent claims.

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Second, as indicated on p. 9, lines 11-14 of the Application, the “visual-side substrate” is “made of a transparent substrate (21) having a transparent layer 22 lower in reflective index than the substrate, and a transparent electrode 24.” Thus, in this exemplary embodiment, the “visual-side substrate” is a combination of three different elements 21, 22 and 24, each of which are clearly shown in FIG. 1. Thus, the structure of the visual side substrate is clearly described in the instant Application, both in the specification and Figures, and independent claims 1, 20, 21 and 44 each clearly read on such a structure, no matter whether element 21 is recited as a “substrate” or “layer.”

Third, with respect to the Examiner’s “self-enabling” comment, this is the first time the Examiner has put forth such an analysis. With respect to the Examiner’s assertion that claims can be species, Applicants disagree, for at least the reasons discussed in the section immediately above. With respect to the Examiner’s assertion that the features of independent claim 1 are somehow different than the underlying descriptive portion of the specification, Applicants disagree, for at least the reasons discussed in the paragraph immediately above.

V. Conclusion

Thus, Applicants respectfully request the withdrawal of this election requirement, and the issuance of a new *Office Action* considering independent claims 21 and 40 (and dependent claims 22-39).

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With respect to the specific exemplary embodiments discussed above, Applicants respectfully submit that these exemplary embodiments are presented for the Director's convenience, and are not intended to limit the scope of the claims.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



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